

Application Serial No. 10/583,881
Reply to Office Action of October 15, 2008

PATENT
Docket: CU-4891

REMARKS

In the Office Action dated October 10, 2008, the Examiner rejected claim 6 under 35 U.S.C. §112, second paragraph, for being indefinite. The Examiner also rejected claims 1-11 under 35 U.S.C. §103(a). The Applicant asserts that the rejections set forth in the Official Action have been overcome by amendment and/or are traversed by argument below.

Claim 1 has been amended to recite that the paper is washed with water "in" as opposed to "using" a rotary drum type. Claim 1 is also amended to clarify that the gypsum component adhering to the paper piece is washed off from the paper piece. Claim 1 is further amended to add the step of "previously dispersing". These amendments to claim 1 are fully supported by the original disclosure, for instance, original claims 1, 4, and 8. Claim 6 has been amended so that claim 6 depends from claim 1. Claim 8 has also been amended herein to clarify that the gypsum component adhering to the paper piece is washed off from the paper piece. Claim 8 is further amended to recite that the apparatus comprises a device configured to disperse or mix the separated paper piece into water before washing the separated paper piece with water. Support for the amendments to claim 8 can be found in the original disclosure, for instance in original claims 8 and 10. No new matter has been added by way of these amendments. The amendments to the claims can be viewed in the Amendments section in the Listing of claims beginning on page 3 of this paper.

Rejection of claim 6 under 35 U.S.C. §112, second paragraph.

The Examiner rejected claim 6 under 35 U.S.C. §112, second paragraph, for being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

In response, the Applicant has amended claim 1 to provide antecedent basis for the term "previously dispersing or mixing the separated paper piece into a portion of wash water" as is found in claim 6. The Applicant respectfully asserts, therefore, that

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this ground of rejection of claim 6 is moot and requests that the Examiner withdraw this ground of rejection of claim 6.

Rejection of claims 1-11 under 35 U.S.C. §103(a).

The Examiner rejected claims 1-11 under 35 U.S.C. §103(a) as being unpatentable over JP 06-142638, Satoru et al., in view of Hamilton (Pulp and Paper Manufacture: Secondary Fibers and Non-wood Pulping). The Applicant notes claims 4 and 10 have been cancelled by this amendment, and therefore, any rejection as to those claims is moot and should be withdrawn.

The Applicant respectfully disagrees.

To establish prima facie obviousness all the limitations of a claimed invention must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP 2143.03. The cited reference does not teach or suggest all the limitations of the Applicant's invention, alone or in combination.

Amended claims 1 and 8 recite the features not disclosed or suggested by Satoru et al. or Hamilton, alone or in combination.

In particular Hamilton discloses a "gravity decker" wherein a fine mesh wire retains shorter fibers and "a thinner mat of fibers is formed," allowing dispersed ink and filler solids to pass through with water. (Hamilton, p. 196-199, Figs. 82-84, and specifically page 198 right col. LL. 8-12.) The "gravity decker", however, does not separate ink from a paper fiber, but instead, separates paper fibers from water containing ink having been dispersed therein. The ink is not "adhering" to the paper as is the case in claims 1 and 8.

Hamilton further explains that "Once the ink has been removed from the fiber, generally by chemical or mechanical means, there are three basic approaches to its

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removal from the aqueous pulp slurry." Clearly, therefore, the ink is removed from the paper prior to separating paper fibers from water containing ink.

Accordingly neither Saturo et al. nor Hamilton disclose the feature of claim 1 of "washing the separated paper piece with water in a rotary drum-type washing device so as to eliminate a gypsum component adhering to the paper piece from the paper piece".

Similarly, claim 8 recites "a rotary drum-type washing device configured to wash the separated paper piece with water so as to eliminate a burnt gypsum component adhering to the paper piece from the paper piece". This feature is similarly not disclosed or suggested by the references.

Specifically, Hamilton discloses a "gravity decker" wherein a fine mesh wire retains shorter fibers and "a thinner mat of fibers is formed, allowing dispersed ink and filler solids to pass through with water. (Hamilton, p. 196-199, Figs. 82-84, and specifically page 198 right col. LL. 8-12.) The "gravity decker" is not, therefore provided to separate ink from a paper fiber, but instead, to separate paper fibers from water containing ink having been dispersed therein. The "gravity decker" of Hamilton would not disclose or suggest that an ink component adhering to a paper fiber can be eliminated from the paper fiber in the "gravity decker".

As with claim 1, neither Saturo et al. nor Hamilton disclose or suggest all of the elements of claim 8, wholly or in combination.

Claims 1 and 8 are non-obvious, therefore, and the Applicant respectfully requests that the Examiner withdraw this ground of rejection as to claims 1 and 8.

It is axiomatic that if an independent claim is allowable, then any claim depending therefrom is also allowable. Since Claims 2-3 and 5-7 depend from claim 1 and claims 9 and 11 depend from claim 8, the Applicant respectfully requests that the remarks made over Claims 1 and 8 be both reflected in the dependent claims and also

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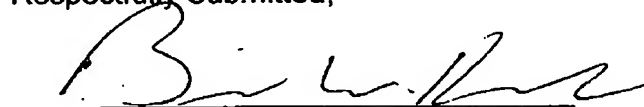
overcome the rejections of those claims. In fact, any additional elements as are found in the claims depending therefrom further serve to distinguish the claims from the alleged prior art. At least for these reasons Claims 2-3, 5-7, 9, and 11 are also non-obvious. The Applicant thus respectfully requests that the Examiner withdraw the rejection of Claims 1-11 under 35 U.S.C. § 103(a).

CONCLUSIONS

The Applicant respectfully contends that all conditions of patentability are met in the pending claims. The Applicant respectfully submits that this application should be in condition for allowance. Furthermore, the Applicant respectfully requests favorable consideration.

Respectfully Submitted,

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Brian W. Hameder, Pat. Reg. No. 45,613

Ladas & Parry, LLP
224 South Michigan Avenue
Suite 1600
Chicago, IL 60604
312/427-1300
312/427-6668 (fax)